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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,327	11/23/2001	Paul H. Morrill JR.	5525/003	2659

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EXAMINER

MYHRE, JAMES W

ART UNIT

PAPER NUMBER

3622

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Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. <b>09/990,327</b>	Applicant(s) <b>Morrill, Jr.</b>
	Examiner <b>James W. Myhre</b>	Art Unit <b>3622</b>



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (e). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on Nov 23, 2001
- 2a)  This action is FINAL.      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1-98 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) 1-8 is/are allowed.
- 6)  Claim(s) 9-98 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

- 15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 9-98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hassett (5,805,082).

Claims 9, 17, 20, 26, 29, 35, 38, 44, 47, 53, 54, 62, 65, 71, 74, 80, 83, 89, 92, and 98: Hassett discloses a method for transferring funds between different accounts, comprising:

- a. Sending/receiving wireless device identification information transmitted by a wireless device (col 5, lines 23-26 and col 20, lines 40-42);
- b. Entering a function code (instruction code) which identifies the desired transaction (col 8, lines 54-67);
- c. Authorizing the transaction (col 14, lines 65-67 and col 28, lines 12-33);
- d. Determining the accounts involved in the transaction (col 4, lines 20-27 and col 18, lines 38-39); and
- e. Processing and confirming the transaction (col 16, lines 33-36).

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While Hassett discloses that the transaction being performed pertains to the collection of tolls for vehicles using a toll road, it is not explicitly disclosed that the transaction could be the transfer of funds to pay for parking fees, goods, services, or public transit fares or to check on the balance of the source account. Official Notice is taken that these types of transactions are among the multitude of well known transaction types involving transfer of funds from one account to another. Furthermore, the type of transaction being performed does not affect the method steps involved in transferring the funds. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the funds transferring method of Hassett in other types of transactions, such as parking fees, goods, service, public transit fare, or merely to check the account balance of the source account. One would have been motivated to use the method for other types of transactions in order to expand the utility of the transponder, especially in reference to the payment of parking fees since the transponder would not require removal from the vehicle (although Hassett does disclose that the transponder could be “housed in a compact, portable enclosure adapted for removable attachment to a dashboard surface or other convenient location within the vehicle” (col 16, lines 17-20)).

Claims 10, 11, 18, 19, 27, 28, 36, 37, 45, 46, 55, 56, 63, 64, 72, 73, 81, 82, 90, and 91: Hassett discloses a method for transferring funds between different accounts as in Claims 9, 17, 26, 35, 44, 54, 62, 71, 80, and 89 above, and further discloses that the funds amount is either a pre-set amount or a variable amount identified by the wireless device and sent to the central processing unit (col 14, lines 12-15).

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Claims 12, 13, 21, 22, 30, 31, 39, 40, 48, 49, 57, 58, 66, 67, 75, 76, 84, 85, 93, and 94:

Hassett discloses a method for transferring funds between different accounts as in Claims 9, 20, 29, 38, 47, 54, 65, 74, 83, and 92 above, and further discloses that the source account is identified from the wireless identification information and the destination account is identified by the function code information (col 28, lines 12-33).

Claims 14-16, 23-25, 32-34, 41-43, 50-52, 59-61, 68-70, 77-79, 86-88, and 95-97:

Hassett discloses a method for transferring funds between different accounts as in Claims 9, 21, 31, 38, 47, 54, 66, 75, 83, and 92 above, and further discloses using a keypad of the wireless device to enter the information (col 15, line 61 - col 16, line 3).

*Allowable Subject Matter*

3. Claims 1-8 contain allowable subject matter.
4. The following is a statement of reasons for the indication of allowable subject matter:

Prior art was found which disclosed remotely transferring funds between different accounts using personal computers and telephones (Kight et al, 5,383,113)(Benton, 4,341,951) (Atalla, EP 131,906). However, prior art could not be located which identified the user's account and completed the desired transaction based on the identification number of the cellular phone (i.e. user identification information transmitted on the subchannel of a cellular phone or other wireless telecommunications device) which is automatically transmitted to the service provider upon activation of the phone.

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***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- A. Bayne et al (3,602,881) discloses a method for automatic toll charging using a remote wireless device in which the tolls are later deducted from the user's bank account.
- B. Wolf et al, (3,652,795) discloses a telephonic transaction system which uses a touch-tone telephone to send transaction data to a bank to transfer funds between a user's account and a merchant's account. The invention also uses a "secret purchaser number" to identify the user.
- C. Bomar, Jr. (3,720,911) discloses a method for using a remote wireless device to control the speed of a vehicle and also to control access to limited access areas, operating toll road stations, parking lot tolls, bridge tolls, the condition of the vehicle and/or driver, emergency signaling, etc.
- D. Powell, (4,320,387) discloses an apparatus and method for securely completing a remote financial transaction between two individuals.
- E. Lennington (4,325,146) discloses a method for identifying a vehicle using an interactive transponder which has an automatic or manual switch. Uses for the invention are noted as toll road and parking lot payments.
- F. Walker (4,845,636) discloses a remote transaction system used to conduct business transaction between two individuals. The system provides "face-to-face" transactions by including video links and cameras (or video phones) at both ends.

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G. Benton et al (4,926,325) discloses an apparatus for carrying out remote electronic financial transactions using a facsimile machine.

H. Benton et al (4,960,981) discloses an apparatus for carrying out electronic funds transfers using a facsimile machine.

I. Keyser et al (5,025,373) discloses a portable personal banking system which uses a pocket terminal to connect to the "dial-up" telephone lines while completing banking services.

J. Hassett et al (5,086,389) discloses essentially the same method for automatic toll processing using a remote wireless device as in the cited reference used in the rejection above.

K. Hitchcock (5,157,717) discloses a portable automatic teller machine which plugs into any existing telephone outlet to complete financial transactions such as funds transfer, bill payments, etc.

L. Claus et al (5,310,999) discloses a method for automatic toll collection which debits a smart card or charges the motorist's account for both fixed and variable tolls, or for other goods and services "such as roadside telephones, restaurants, gasoline, and even speeding tickets".

M. Shieh (5,424,727) discloses a method for toll collection using a remote wireless device.

N. Hilt et al (5,465,206) discloses an electronic bill pay system using a computer system. Hilt also discloses specific embodiments in which the user connects and uses the system via a telephone keypad.

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O. Moss et al (5,485,370) discloses a home delivery system which uses a terminal shaped like a telephone to complete remote ordering transactions and funds transfers.

P. Bezos (5,727,163) discloses a system which combines computer ordering with telephonic confirmation of the transaction.

Q. Hassett (5,751,973) discloses an electronic parking management method which uses a transceiver to control and authorize access to a secure location.

R. Randle (5,787,403) discloses a system which allows users to use banking services and other services via telephonic communication equipment. Randle also discloses using the system to control access to secure locations.

S. Khan et al (6,263,316) discloses a method for processing retail transactions using a remote wireless device in a vehicle which deducts the transaction amount from a pre-paid account or as a charge to the consumer's credit account. This reference essentially discloses the claimed invention but was filed after the present application.

T. Janning et al (6,446,049) discloses a method for processing commercial transactions using a remote wireless device. This reference essentially discloses the claimed invention but was filed six weeks after the present application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9326. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.

JWM

February 13, 2003

James W. Myhre  
Primary Examiner  
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